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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/614,399

07/03/2003

Louis Brown Abrams

4811-18

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06/01/2007

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER, CO 80202

EXAMINER

JUSKA, CHERYL ANN

ART UNIT

PAPER NUMBER

1771

MAIL DATE

DELIVERY MODE

06/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/614,399

Applicant(s)

ABRAMS, LOUIS BROWN

Examiner

Cheryl Juska

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27, 29-40, 42-47 and 49-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27, 29, 30, 32-40, 42-47 and 49-56 is/are rejected.
- 7) ☒ Claim(s) 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/07</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Response to Amendment

2. Applicant's amendment originally filed After Final on March 8, 2007, and entered per the RCE on April 4, 2007, has been entered. Claims 29-32, and 42 have been amended as requested. Claims 1-26, 28, 41, and 48 are cancelled, while new claims 52-56 have been added. Thus, the pending claims are 27, 29-40, 42-47, and 49-56.

Double Patenting

3. Claims 27, 29-40, 42-47, and 49-51 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4-11 and 27-41 of copending Application No. 10/614,340, as set forth in section 4 of the last Office Action (Final Rejection, 01/10/07). Applicant's willingness to file a Terminal Disclaimer upon indication of allowable subject matter is acknowledged.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 32 and 53-56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not provide adequate support for the following claimed subject:

- a. the adhesive film being located only in a desired area of the backing film (claim 32),
- b. a first set of flock fibers adhere to the adhesive film and a second set of flock fibers don not adhere to the adhesive film (claim 32),
- c. forming a plurality of adhesive-containing areas and at least one area free of adhesive on a first surface of a backing film (claim 53), and
- d. applying flock to the adhesive-containing areas but not to the at least one area free of adhesive (claim 53).

Therefore, claims 32 and 53 are rejected as containing new matter. Claims 54-56 are also rejected for their dependency upon claim 53.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 27, 29, 30, 33-40, 42-47, and 49-51 stand rejected under 35 U.S.C. 103(a) as being unpatentable over JP 56-058824 issued to Kondo et al. in view of JP 58-062027 issued to Moriyama et al., US 4,810,549 issued to Abrams et al., and US 6,646,022 issued to Okazaki et al. as set forth in previous Office Actions.

With respect to the new limitations of claims 29 and 30, Okazaki teaches shaping a decorative mold insert to follow the shape of the mold prior to inserting and arranging the insert in the mold (col. 21, lines 47-67). Hence, the pre-shaped mold insert would be self-aligning and self-locating in the mold and be prevented from dislodgment from the desired position during the introduction of molding resin.

8. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 56-058824 issued to Kondo et al. in view of JP 58-062027 issued to Moriyama et al., US 4,810,549 issued to Abrams et al., and US 6,646,022 issued to Okazaki et al.

Regarding new claim 52, the Abrams reference is cited for its teaching of the features of flock transfers, including carrier or release sheets and release adhesive. Thus, claim 52 is rejected for the reasons of record.

Allowable Subject Matter

9. Claim 31 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to teach or fairly suggest forming an intermediate

transfer, cutting said transfer into the desired portion, and laminating the desired portion to the backing film to form the mold insert.

Response to Arguments

10. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive. Many of applicant's arguments are repeated from the last response. As such, applicant's attention is directed to sections 8-14 of the last Office Action. Additionally, the following comments are made.

11. Applicant traverses the above rejection by asserting that the references fail to teach or suggest certain features of the present claims (Amendment, page 9, 1st paragraph, page 10, 2nd paragraph, page 12, 1st paragraph, and page 13, 2nd paragraph). Accordingly, the rejection of the claims is not based upon any of the references alone, but rather is based upon Kondo in view of Moriyama, Abrams, and Okazaki. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant has not sufficiently traversed the motivation to combine the references to form the *prima facie* case of obviousness.

12. Applicant also traverses the examiner's arguments by asserting that "she disregards the teachings of Moriyama that the thermoplastic film must melt bond to the foamed resin or else the purpose of the Moriyama invention would be frustrated" (Amendment, page 13, 3rd paragraph). However, this argument is unpersuasive since Moriyama is merely relied upon to teach that

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flocked layers are known decorative layers for molded articles. The particular features of Moriyama's mold process are not necessarily relevant.

13. To reiterate, regarding Kondo's lack of a teaching of a decorative flock layer, as noted in the prior Office Action, it would have been readily obvious to substitute a decorative flock layer, as taught by Moriyama, for the decorative layer of Kondo since Moriyama establishes that flock layers are suitable decorative layers for molded articles. Regarding the use of a thermosetting adhesive as the adhesive layer bonding the flock to the backing film, it was previously argued that it would have been readily obvious to one of ordinary skill in the art to select a thermosetting adhesive for the adhesive of Kondo. Motivation to do so would be to produce a very secure bond between the decorative flock material and the backing material. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. Additionally, it would have been obvious to modify the invention suggested by Kondo, Moriyama, and Abrams, with the Oakazaki teaching of shaping a decorative mold insert prior to inserting and arranging said insert in the mold. Furthermore, upon employing a thermosetting adhesive, said adhesive would be thermoset or fully activated upon thermal shaping of the mold insert prior to its placement in the mold. Therefore, the rejections stand.

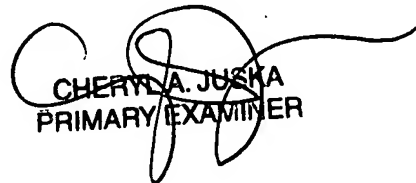
Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the

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examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHERYL A. JOSHUA
PRIMARY EXAMINER

cj
May 28, 2007